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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/961,036	09/21/2001	Madhav Datta	884.523US1	4661
21186	7590	04/08/2004	EXAMINER	
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402			ART UNIT	PAPER NUMBER

DATE MAILED: 04/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Notification of Non-Compliance
With 37 CFR 1.192(c)**

Application No.

09/961,036

Applicant(s)

DATTA ET AL.

Examiner

Erik Kielin

Art Unit

2813

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The Appeal Brief filed on 09 January 2004 is defective for failure to comply with one or more provisions of 37 CFR 1.192(c). See MPEP § 1206.

To avoid dismissal of the appeal, applicant must file IN TRIPLICATE a complete new brief in compliance with 37 CFR 1.192(c) within the longest of any of the following three **TIME PERIODS**: (1) **ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer; (2) **TWO MONTHS** from the date of the notice of appeal; or (3) within the period for reply to the action from which this appeal was taken. **EXTENSIONS OF THESE TIME PERIODS MAY BE GRANTED UNDER 37 CFR 1.136.**

1. ☐ The brief does not contain the items required under 37 CFR 1.192(c), or the items are not under the proper heading or in the proper order.
2. ☐ The brief does not contain a statement of the status of all claims, pending or cancelled, or does not identify the appealed claims (37 CFR 1.192(c)(3)).
3. ☐ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 1.192(c)(4)).
4. ☐ The brief does not contain a concise explanation of the claimed invention, referring to the specification by page and line number and to the drawing, if any, by reference characters (37 CFR 1.192(c)(5)).
5. ☒ The brief does not contain a concise statement of the issues presented for review (37 CFR 1.192(c)(6)).
6. ☒ A single ground of rejection has been applied to two or more claims in this application, and
 - (a) ☐ the brief omits the statement required by 37 CFR 1.192(c)(7) that one or more claims do not stand or fall together, yet presents arguments in support thereof in the argument section of the brief.
 - (b) ☒ the brief includes the statement required by 37 CFR 1.192(c)(7) that one or more claims do not stand or fall together, yet does not present arguments in support thereof in the argument section of the brief.
7. ☒ The brief does not present an argument under a separate heading for each issue on appeal (37 CFR 1.192(c)(8)).
8. ☐ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 1.192(c)(9)).
9. ☒ Other (including any explanation in support of the above items):

See attached sheet.

**NOTIFICATION OF NON-COMPLIANCE WITH THE
REQUIREMENTS OF 37 CFR 1.192(c)**

Regarding item 6 on the previous page, the brief includes a statement that claims 17, 19, 21, 23, and 25 do not stand or fall together, but fails to present reasons in support thereof as required under 37 CFR 1.192(c)(7). MPEP § 1206.

Regarding item 5 above, the Brief does not state that there is an issue, or what is the issue regarding claim 18, yet provides arguments directed to claim 18. Additionally, each issue should be treated under a separate heading, yet none is provided for the separate issue regarding claim 18.

The Brief is additionally defective because Applicant presents arguments drawn to petitionable --rather than appealable-- subject matter, i.e. the drawings. The Board does not entertain issues drawn to 37 CFR matters (i.e. petitionable subject matter) but instead to statutory matters (i.e. the claims). (See MPEP § 1201.) In this regard, 37 CFR § 1.191(c) states,

“An appeal when taken must be taken from the rejection of all **claims** under rejection which the applicant or patent owner proposes to contest. Questions relating to matters not affecting the merits of the invention may be required to be settled **before** an appeal can be considered.”
(Emphasis added.)

The drawings are not drawn to the merits of the invention (i.e. the claims), but rather to petitionable subject matter and should be resolved prior to consideration of the appeal.

Moreover, in as much as Applicant failed to petition the objection to the drawings within two month, it appears that Applicant has waived the right to petition the matter. (See 37 CFR 1.181(f).) Note that the objection to the drawings will **not** be held in abeyance.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erik Kielin whose telephone number is 571-272-1693. The examiner can normally be reached on 9:00 - 19:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Whitehead, Jr. can be reached on 571-272-1702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Erik Kielin
Primary Examiner
6 April 2004